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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,627

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EXAMINER

GRAYBILL, DAVID E

ART UNIT

PAPER NUMBER

2822

MAIL DATE

DELIVERY MODE

12/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,627

Applicant(s)

LANDSBERGER, LESLIE M

Examiner

David E. Graybill

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 and 20-31 is/are allowed.
- 6) ☐ Claim(s) 19 and 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claims 1-43 features, including the claims 19, 32 and 33 features, "wherein said layer of protective material is a liquid material," "a protective layer of material substantially filling said packaging," and, "wherein said layer of protective material is a liquid material" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

To further clarify, there are no reference characters in the drawings or elsewhere in the disclosure to enable determination of the features of the claims shown in the drawings, and the features of the claims shown in the drawings are otherwise indeterminable.

To further clarify the objection relevant to the claim 32 feature, the term "substantially" means *being largely but not wholly that which is specified* and the drawings do not show the feature of a protective layer of material largely but not wholly filling said packaging.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is

to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show all of the details as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

To further clarify, there are no reference characters in the drawings or elsewhere in the disclosure to enable determination of the details of the specification shown in the drawings, and the details of the specification shown in the drawings are otherwise indeterminable.

The disclosure is objected to because there are no reference characters in the drawings or elsewhere in the disclosure to enable determination of the details of the specification shown in the drawings, and the details of the specification shown in the drawings are otherwise indeterminable.

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The undescribed subject matter is the limitation, "a protective layer of material substantially filling said packaging."

To further clarify, the term "substantially" means being *largely but not wholly that which is specified* and one skilled in the art would be unable make and or use a protective layer of material largely but not wholly filling said packaging.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 19 and 33 the limitation, "wherein said layer of protective material is a liquid material that becomes solid at room temperature" is

incompatible with the claims 16 and 32 limitations, respectively, "wherein said protective material is in a solid state at room temperature" because the material cannot be both a liquid and in a solid state. Moreover, the scope of the claims 19 and 33 language, "is a liquid material that becomes solid at room temperature" is indeterminable because the material of claims 16 and 19 is at room temperature, hence it is a solid and not a liquid.

Claims 1-18 and 20-31 are allowed.

Applicant's amendment and remarks filed 9-26-7 have been fully considered, are treated supra, and are further addressed infra.

Applicant states, "The Examiner alleges that the limitation introduced in claims 19 and 33, namely 'wherein said layer of protective material is a liquid material' appears to be incompatible with claims 16 and 32, which state 'wherein said protective layer is in a solid state'. The full citation from claims 19 and 33 is actually 'wherein said layer of protective material is a liquid material that becomes solid at room temperature'. Therefore, the Applicant respectfully submits that there is no incompatibility between claims 19 and 33, and claims 16 and 32, respectively."

This statement is respectfully deemed unpersuasive because it is a non-sequitur. Specifically, the inference, "there is no incompatibility between claims 19 and 33, and claims 16 and 32, respectively" does not follow from the premises, "The Examiner alleges that the limitation

introduced in claims 19 and 33, namely 'wherein said layer of protective material is a liquid material' appears to be incompatible with claims 16 and 32, which state 'wherein said protective layer is in a solid state'. The full citation from claims 19 and 33 is actually 'wherein said layer of protective material is a liquid material that becomes solid at room temperature'."

To continue to afford applicant the benefit of compact prosecution it is noted that the claims 16 and 33 (and incidentally, claim 1) language, "wherein said protective material is in a solid state at room temperature" limits the claims to the material being at room temperature. Also, the claims are not limited to a solid material which, when liquid, becomes solid at room temperature.

Also, applicant asserts, "An example of a 'protective layer of material substantially filling said packaging' can be found in Figure 8. The following passage can be found at page 9, line 30 to page 10, line 1: 'Fig. 8 shows how such a chip with protected microstructures could be embedded within an injection-molded plastic package. The bonding, wires extend through the plastic to make contact with external electric circuitry,'" and, "The Applicant respectfully submits that Figure 8 fully shows the "protective layer of material substantially filling said packaging'. As per the statements made above, the passage found at page 9, line 30 to page 10, line 1 is evidence of this."

These assertions are respectfully deemed unpersuasive because applicant merely cites without elucidation, and the citations do not otherwise appear to support the allegation. In particular, the claim language "protective layer of material," "substantially filling" and "packaging" is not recited at the referenced citations. In addition, the parts of Figure 8 that show the protective layer of material substantially filling said packaging are not identified or otherwise apparent.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

For information on the status of this application applicant should check PAIR: Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours:

Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is (571) 273-8300.



David E. Graybill
Primary Examiner
Art Unit 2822

D.G.

8-Dec-07